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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,466	07/11/2001	Scott D. Bauman	7599	9336

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ONDEO Nalco Company
Patent & Licensing Department
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EXAMINER

HRUSKOCI, PETER A

ART UNIT PAPER NUMBER

1724

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s) <i>PLC</i>	
	09/903,466	BAUMAN ET AL.	
	Examiner	Art Unit	
	Peter A. Hruskoci	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2001 and 07 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17, drawn to an apparatus and system, classified in class 210, subclass 96.1.

II. Claims 18-20, drawn to a method, classified in class 210, subclass 696.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used in a materially different method such as a papermaking method.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Kelly L. Cummings on 1-14-03 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 18-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 “the water cooling system” lacks clear antecedent basis.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hays et al. in view of Hoots et al.. Hays et al. disclose (see col. 6 lines 19-65, col. 13 line 5 through col. 14 line 32, and col. 18 lines 14-37) the structure of the apparatus substantially as claimed. The claims differ from Hays et al. by reciting that the system

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includes a bleed pump electrically communicating with the controller. Hoots et al. disclose (see col. 1 lines 49-65) that it is known in the art to open a valve or pump with a controller to start blowdown or bleed of cooling water from a cooling water system. It would have been obvious to one skilled in the art to modify the apparatus of Hays et al. by including the recited bleed pump in view of the teachings of Hoots et al., to aid in controlling the bleeding of cooling water from the apparatus. With regard to claim 3, it is submitted that Hoots et al. disclose (see col. 1 line 66 through col. 2 line 4) the use of a timer in conjunction with a controller to control the bleed of cooling water from a cooling water system. The use of a hydraulic connection between the containers would have been an obvious matter of engineering design to one skilled in the art, depending on the specific treatment agents utilized and results desired, absent a sufficient showing of unexpected results.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hays et al. in view of Hoots et al. as above, and further in view of O'Leary 4,464,315. The claim differs from the references as applied above by reciting that the apparatus comprises a 12 volt power source. O'Leary disclose (see col. 7 line 11 through col. 10 line 65) that it is known in the art to utilize the recited power source to provide power to the automatic controller of a cooling water system. It would have been obvious to one skilled in the art

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to modify the references as applied above by including the recited power source in view of the teachings of O'Leary, to provide power for the apparatus.

10. Claim 7 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hays et al. in view of Hoots et al. as above, and further in view of Takahashi. The claims differ from the references as applied above by reciting that the bleed pump is a submersible pump that is located in the aqueous system. Takahashi disclose (see col. 5 line 63 through col. 6 line 59) that it is known in the art to utilize a submersible pump 7 to aid in bleeding water from a cooling water system. It would have been obvious to one skilled in the art to modify the references as applied above by the recited pump in view of the teachings of Takahashi, to aid in bleeding water from the apparatus and system.

11. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hays et al. in view of Hoots et al. and Takahashi as above, and further in view of O'Leary 4,464,315. The claims differ from the references as applied above by reciting that the apparatus comprises a 12 volt power source. O'Leary disclose (see col. 7 line 11 through col. 10 line 65) that it is known in the art to utilize the recited power source to provide power to the automatic controller of a cooling water system. It would have been obvious to one skilled in the art to modify the references as applied above by including the recited power source in view of the teachings of O'Leary, to provide power for the apparatus.


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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (703) 308-3839. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached on (703) 308-1972. The fax phone number for this Group is (703) 872-9310 (non-after finals) and 703-872-9311 after finals.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Peter A. Hruskoci
Primary Examiner
Art Unit 1724

P. Hruskoci
January 22, 2003